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| 09/749,720      | 12/28/2000  | Isao Yagasaki        | 826.1658            | 6774             |

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EXAMINER

BORISSOV, IGOR N

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3629

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/749,720

Applicant(s)

YAGASAKI ET AL.

Examiner

Igor Borissov

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 11-13 are rejected under 35 U.S.C. 101** because the claimed method for membership qualification does not recite a limitation in the technological arts. The independently claimed steps of: storing a plurality of membership conditions of the plurality of services; comparing, among the plurality of membership conditions, a membership condition of a service of which a user has become a member with a membership condition of a service of which the user has not become a member and selecting a service of which the user can become a member; and displaying information about the service on the screen, are abstract ideas which can be performed mentally without interaction of a physical structure or. The method step: "displaying information about the service on the screen" may be understood as merely presenting a sheet of paper with hand-written signs on it. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)).

Because the independently claimed invention is directed to an abstract idea which does not produce a useful, concrete and tangible result, those claims and claims depending from them, are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peirce et al. (US 6,332,126) in view of Yoshioka et al. (US 5,918,215).**

Peirce et al. teach a system and method for a targeted payment system discount program, comprising:

**As per claims 1-2, 8, 11, 14 and 17,**

- a storing device storing a plurality of criteria of the plurality of services (column 3, line 10-15; column 6, lines 43-45);
- a selecting device comparing, among the plurality of criteria, a criteria of a service of which a user has become a member with a criteria of a service of which the user has not become a member and selecting a service of which the user can become a member (column 2, line 35 – column 3, line 60; column 6, lines 14-54);
- a presenting device presenting information about the service of which the user can become a member to the user (column 3, lines 42-47).

Peirce et al. teach that the criteria include a credit card data of a user. However, Peirce et al. do not specifically teach that criteria comprise a membership conditions.

Yoshioka et al. teach a system and method for content sales price accounting system, wherein the user must register his credit card number in the network service company as a prerequisite (condition) for the registration of the membership of the network service company (column 5, lines 32-48). However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Also, Peirce et al. teach that services are offered to users based on the responses to prior offers from said users (column 6, lines 36-37).

However, Pierce et al. do not specifically teach that said responses to prior offers include a request to present an available membership service.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Peirce et al. and Yoshioka et al. to include that said responses to prior offers include a request to present an available membership service, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of would perform the invention as claimed by the applicant with either specifically teaching a request for an available membership service, or not.

**As per claim 3**, Peirce et al. teach said system and method, further comprising:

- a registering device for registering information that is in common with the at least two services (column 5, line 59 – column 6, line 45);

wherein the receiving device receives information of the user (column 6, lines 15-45; column 8, line 43 – column 9, line 15);

wherein when the information of the user corresponds to the common information, said selecting device obtains the membership conditions of the at least two services based on the information of the user (column 5, line 59 – column 6, line 45).

Peirce et al. do not teach that information comprises certificate information.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

**As per claims 4-5, 9, 12, 15 and 18**, Peirce et al. teach said system and method, comprising:

- a storing device storing identification information of a first service as qualification criterion information for qualifying membership of a second service (column 2, line 35 – column 3, line 60; column 4, line 18 – column 5, line 45);

- a first determining device determining whether or not a user is utilizing the first service when the user wants to become a member of the second service (column 2, line 35 – column 3, line 60; column 6, lines 14-54; column 8, line 43 – column 9, line 15);

- a second determining device determining that the user has a membership qualification for the second service when the user is utilizing the first service (column 2, line 35 – column 3, line 60; column 6, lines 14-54; column 8, line 43 – column 9, line 15).

**As per claims 6, 10, 13, 16 and 19**, Peirce et al. teach said system and method, comprising:

- a storing device storing a membership condition of an existing service (column 2, line 35 – column 3, line 60; column 4, line 18 – column 5, line 45; column 6, lines 15-45);

- a designating device designating a new membership condition (column 2, line 35 – column 3, line 60; column 4, line 18 – column 5, line 45; column 6, lines 15-45);

- a simulating device comparing the membership condition of the existing service with the new membership condition and obtaining information about the number of users who can become members of a service corresponding to the new membership condition (column 2, line 35 – column 3, line 60; column 6, lines 14-54; column 8, line 43 – column 9, line 15);

- an output device outputting the obtained information (column 3, lines 42-47).

**As per claim 7**, Peirce et al. teach said system and method, further comprising:

- a registering device registering a plurality of pieces of certificate information of the plurality of users who are utilizing the existing service (column 2, line 35 – column 3, line 60; column 4, line 18 – column 5, line 45; column 6, lines 14-54; column 8, line 43 – column 9, line 15);

wherein when the new membership condition satisfies the membership condition of the existing service, said simulating device counts the number of the pieces of certificate information and obtains the number of users who can become the members of the service corresponding to the new membership condition column 6, lines 14-54; column 8, line 43 – column 9, line 15).

### ***Response to Arguments***

Applicant's arguments filed 09/03/03 have been fully considered but they are not persuasive.

In response to applicant's argument that Pierce et al. and Yoshioka et al. fail to show "totaled membership condition" by performing "an AND peration", examiner points out that Pierce et al. does, in fact, show this feature (column 6, lines 43-45).

In response to applicant's argument that Pierce et al. fail to disclose that a "receiving information of the user wherein when the information of the user corresponds to the common information" includes "receiving certificate information of the user", examiner points out that there is no indication in the specification that said feature provides the advantage over the prior art. Without such indication, it appears that "receiving information" and "receiving certificate information" are obvious variations of the same feature.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

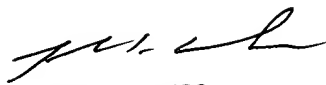
**(703) 872-9306**

[Official communications; including After Final  
communications labeled "Box AF"]

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

IB

  
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